



FEB 19 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 13, 15, 32, 45 and 50 of the morning section and questions 14 and 36 of the afternoon section of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On July 27, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a

question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for afternoon question 36. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 13, 15, 32, 45 and 50 and afternoon question 14. Petitioner's arguments for these questions are addressed individually below.

Morning question 13 reads as follows:

13. The following statements relate to "multiple dependent claims." Which statement is not in accord with proper USPTO practice and procedure?

- (A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.
- (B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.
- (C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.
- (D) Restriction may be required between the embodiments of a multiple dependent claim.
- (E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

The model answer is selection (A).

The answer is inconsistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (B), (C), and (E) are wrong answers because they are consistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (D) is wrong because it is consistent with MPEP § 608.01(n), subpart I. C.

Petitioner argues that answer (B) is correct and selection (A) is incorrect. Petitioner contends that selection (B) may be interpreted as meaning that a multiple dependent claim does not include the limitations explicitly included within the multiple dependent claim nor the limitations of the parent claims to the claims referred to by the multiple dependent claim, both interpretations of which would make (B) a correct answer because neither interpretation accords with USPTO practice and procedure and that selection (A) is an incorrect answer because, in the petitioner's opinion, selection (A) is consistent with MPEP 608.01(n) and 37 CFR 1.75 if selection (A)'s referral to "all of the claims" is equivalent to "each of the claims."

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (B) may be interpreted as meaning that a multiple dependent claim does not include the limitations explicitly included within the multiple dependent claim nor the limitations of the parent claims to the claims referred to by the multiple dependent claim, both interpretations of which would make (B) a correct answer because neither interpretation accords with USPTO practice and procedure and that selection (A) is an incorrect answer because, in the petitioner's opinion, selection (A)

is consistent with MPEP § 608.01(n) and 37 § CFR 1.75 if selection (A)'s referral to "all of the claims" is equivalent to "each of the claims", selection (B) clearly states "A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration." The phrase "limitations of the particular claim referred to" clearly excludes the claims not referred to, but cannot be construed to exclude the limitations in the multiple dependent claim itself. Similarly, the limitations of the parent claim to any claim referred to are incorporated into the claim referred to by operation of 37 § CFR 1.75(c).

More to the point, selection (B) must be consistent and selection (A) must be inconsistent with USPTO practice and procedure because selection (B) and the antithesis of selection (A) are found in a direct quote of MPEP § 608.01(n), subpart I.B.4. stating "a multiple dependent claim, as such, does not contain all the limitations of all the alternative claims to which it refers, but rather contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration." Accordingly, model answer (A) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 15 reads as follows:

15. Which of the following is/are information which the USPTO may require an attorney of record in a reissue application to submit in a reply to a first Office action dated April 12, 2001?

(A) Information used in invention process: A copy of any non-patent literature, published application, or patent

(U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(B) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art.

(C) Comments on a new decision by the Federal Circuit that appears on point in the examination of the application.

(D) (A), (B), and (C).

(E) None of the above.

The model answer is selection (D).

37 CFR § 1.105(a) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000). (A) is specifically stated as an example in 37 CFR § 1.105(a)(1)(v). (B) and (C) are given as examples in 65 FR at 54634, left column, where the Office may require the submission of information. (E) is incorrect because (D) is correct.

Petitioner argues that answer (A) is correct and (D) is incorrect. Petitioner contends that an examiner may not require comments on any new decision related to a claim where a claim has been canceled and that it is unreasonable to expect an examinee to look further than the Code of Federal Regulations and the MPEP to locate additional options.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that an examiner may not require comments on any new decision related to a claim where a claim has been canceled and that it is unreasonable to expect an examinee to look further than the Code of Federal Regulations and the MPEP to locate additional options, the instructions explicitly state "Do not assume any additional facts not presented in the questions" and "The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register." There is no reason to assume that the requirement for information pertains to a canceled claim. The instructions indicate that examinees are to consider Federal Register notices. Selections (B) and (C) are both among the examples cited in 65 FR at 54634, left column. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 32 reads as follows:

32. Which of the following is in accordance with proper USPTO practice and procedure?

(A) After issuance of a notice of allowance in November 2000, a petition to withdraw an application from issue and requisite fee are required if a request for continued examination, submission, and requisite fee are filed prior to the issuance of the patent.

(B) After issuance of a notice of allowance in April 2001 for an application, an amendment of the claims in the application may be filed before, with, or after payment of

the issue fee.

(C) The Office ensures that any petition to withdraw an application from issue, filed after payment of the issue fee, will be acted upon prior to the scheduled date of patent grant.

(D) If a request for continued examination under 37 CFR § 1.114, accompanied by the requisite fee, but not a submission, are filed in March 2001, after an application was allowed in January 2001, the Office will notify the applicant and set a time period within which the deficiency must be corrected.

(E) An amendment filed in the Office in April 2001 in reply to a final rejection must comply with either the provisions of 37 CFR § 1.114 or the provisions of 37 CFR § 1.116(b) and (c).

The model answer is selection (E).

37 C.F.R. §§ 1.114 and 1.116(b) and (c). See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, middle column, second complete paragraph, 50101, Comment 19 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.313(a), third sentence. A petition under § 1.313 is not required if a request for continued examination is filed prior to payment of the issue fee. (B) is not the most correct answer. 37 C.F.R. § 1.312, in pertinent part, provides, "Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, middle column, fourth complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not correct. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50097, right column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). See also 37 CFR § 1.313(d). (D) is not the most correct answer. "The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires the applicant to 'prosecute the application' within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law. (35 U.S.C. 133)." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50102, left column, Comment 20 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that answer (B) is also correct. Petitioner contends that it is possible to

make minor changes after payment of the issue fee at the discretion of the examiner or with a certificate of correction, that the phrasing of (B) is ambiguous as being stated in the alternative so that if any one of the alternatives is true, then the entire statement is true and that amendment may be made after payment of the issue fee if the application is withdrawn from issue.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that it is possible to make minor changes after payment of the issue fee at the discretion of the examiner or with a certificate of correction, that the phrasing of (B) is ambiguous as being stated in the alternative so that if any one of the alternatives is true, then the entire statement is true and that amendment may be made after payment of the issue fee if the application is withdrawn from issue, the instructions clearly state "Do not assume any additional facts not presented in the questions." As to amendments for minor changes and withdrawal from issue, there is no reason to assume amendments are made for minor matters or that amendments are made after withdrawal from issue. As to purported ambiguity, 37 C.F.R. § 1.312, in pertinent part, provides, "Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee" which is clearly unambiguous and is counter to selection (B). Accordingly, model answer (E) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 45 reads as follows:

45. In regard to patent application drawings, which of the following is in accord with proper USPTO practice and procedure?

(A) Views in a drawing may be connected by projection lines, and views may contain center lines in patent applications filed in April 2001.

(B) Photographs must be developed on paper that is DIN size A4 or 8½ by 11 inches, and meet margin requirements set by regulation in applications filed in April 2001.

(C) Color drawings are permitted by regulation, and without further authorization, in an application submitted under the Office electronic filing system in April 2001.

(D) The Office will accept black and white photographs in utility or design applications filed in April 2001 only if three copies of black and white photographs, and a petition and fee are filed to have such photographs accepted.

(E) In applications filed in April 2001, the scale of a drawing must be properly indicated

by statements such as "actual size" or "scale ½."

The model answer is selection (B).

37 C.F.R. § 1.84(e), (f) and(g). See, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031-57032 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (A) is not the most correct answer. 37 CFR § 1.84(j) provides that views in a drawing must not be connected by projection lines, and views must not contain center lines. (C) is not the most correct answer. 37 C.F.R. § 1.84(a)(2) provides that "[c]olor drawings are not permitted in...an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications...only after granting a petition filed under this paragraph explaining why the color drawings are necessary." Any such petition must include a fee and meet the certain requirements set forth in the last sentence of § 1.84(a)(2). See, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.84(b)(1) was "amended to eliminate the requirement for three copies of black and white photographs and a petition to accept such photographs." See, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.84(k) provides that "Indications such as 'actual size' or 'scale ½' on the drawings are not permitted since these lose their meaning with reproduction in a different format." See, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

Petitioner argues that answer (D) is correct. Petitioner contends that (D) is consistent with MPEP 7th edition and that it was impractical to review the Federal Register.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is consistent with MPEP 7th edition and that it was impractical to review the Federal Register, the instructions clearly stated "The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register." Answer (D) is inconsistent with Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). This Federal Register provision modified the contents of MPEP 7th edition. The relevance of the practicality of reviewing required examination material to the correctness of this exam question is unclear, but in any event does not alter the identification of selection (B) as

the correct answer. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 50 reads as follows:

50. An article in a popular scientific journal, dated January 13, 2000, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which of the following claims in an application filed January 22, 2001 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 2. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

(A) Claim 1.

(B) Claim 2.

(C) Claim 3.

(D) Claims 2 and 3.

(E) None of the above.

The model answer is selection (D).

MPEP § 2173.05(h), and Ex Parte Cordova, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (A) is incorrect since the article does not disclose a metallic shoelace, whereas Claim 1 requires a telecommunications device having a metallic shoelace. Since the "optional" element does not have to be disclosed in a

reference for the claim to be anticipated, claims 2 and 3, which provide for inclusion of optional elements, are each anticipated by the article. Thus, (B), and (C), are incorrect. Inasmuch as (C) is correct, (E) is incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that claims 2 and 3 are both indefinite for failure to show how the additional shoelace and memory elements are connected.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that claims 2 and 3 are both indefinite for failure to show how the additional shoelace and memory elements are connected, petitioner makes only a conclusory statement that the claims are indefinite and does not cite any support for the assertion that the absence of relating elements explicitly recited in a claim is a cause of indefiniteness. To petitioner's statement that it is unclear how the elements are connected, the claims must be read in light of the specification. To the extent the petitioner is suggesting that claim 2 and 3 are indefinite aggregations of elements, MPEP 2173.05(k) indicates this is only the case where there is lack of, i.e. not merely unrecited, cooperation. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 14 reads as follows:

14. Which of the following statements concerning a restriction requirement in a reissue application filed January 10, 2001, is in accordance with proper USPTO rules and procedure?

(A) The Office cannot properly make a restriction requirement in the reissue application between claims added in the reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention defined by the original patent claims.

(B) The Office cannot properly make a restriction requirement involving only subject matter of the original patent claims.

(C) If restriction is required by the Office, the subject matter of the original patent claims will not be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

(D) (A) and (B)

(E) None of the above.

The model answer is selection (B).

37 CFR § 1.176(b) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54644 (September 8, 2000). As stated in 65 FR at 54644, left column, "Section 1.176(b) now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims." Thus (A) is incorrect. (C) is incorrect because the original patent claims "will be held to be constructively elected..." 37 CFR § 1.176(b). (D) is incorrect because (A) is incorrect. (E) is incorrect because (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that (D) is consistent with MPEP 7th edition and that it was impractical to review the Federal Register.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is consistent with MPEP 7th edition and that it was impractical to review the Federal Register, the instructions clearly stated "The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register." Answer (D) is inconsistent with Changes to Implement The Patent Business Goals, Final Rule, 65 FR at 54644, left column, "Section 1.176(b) which now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims." This Federal Register provision modified the contents of MPEP 7th edition. The relevance of the practicality of reviewing required examination material to the correctness of this exam question is unclear, but in any event does not alter the identification of selection (B) as the correct answer. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

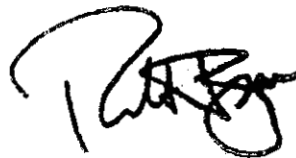
No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy